

REMARKS

By the above amendment, claims 3 - 25, 28 - 31 and 36 - 39 have been canceled without prejudice or disclaimer of the subject matter thereof with claims 26, 27, 32 and 33 being written in independent form. It is noted that claims 26, 27, 32 and 33 were essential multiple dependent upon independent claims 11 or 12. Thus, claims 26, 27, 32 and 33, as written in independent form incorporate the features of independent claim 11 and intermediate dependent claims therein. Furthermore, new independent claims 40 - 43 have been presented corresponding respectively to the features of claims 26, 27, 32 and 33 incorporating the features of independent claim 12 therein. Applicants note that new dependent claims 44 and 45 correspond to dependent claims 34 and 35 and depend from claim 43.

As to the rejection of claims 3 - 5, 8 - 10 and 39 under 35 USC 103(a) as being unpatentable over Akimoto et al (WO97/11447) which is a PCT of US Patent 6,329,973; the rejection of claims 6 and 39 under 35 USC 103(a) as being unpatentable over Akimoto et al in view of Akiyama, US 5,952,991; the rejection of claims 7 and 39 under 35 USC 103(a) as being unpatentable over Akimoto et al in view of Shibahara, US 6,104,463; the rejection of claims 11 - 12, 15 and 36 - 38 under 35 USC 103(a) as being unpatentable over Akimoto et al in view of Miyoshi, US 6,339,446 B1; the rejection of claims 13 - 14, 17 - 23, 26 - 30 and 32 - 35 under 35 USC 103(a) as being unpatentable over Akimoto and Miyoshi, further in view of Shibahara; and the rejection of claims 16, 24 - 25 and 31 under 35 USC 103(a) as being unpatentable over Akimoto, Miyoshi and Shibahara further in view of Nakakuki, US 6,160,593; such rejections are obviated insofar as they are applicable

to claims which have been canceled and are traversed insofar as they are applicable to the claims written in independent form and dependent claims thereof, as well as the new claims corresponding thereto.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user

friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

In setting forth the rejection in relation to claims 26, 27 and 32, the Examiner states that "Shibahara discloses a lighting device for moving light emitting region in synchronism with a scanning signal applied to the scanning line (col. 4; col. 5, lines 1 - 48; col. 7, lines 20 - 67; col. 8, lines 1 - 10)". Irrespective of the Examiner contention, applicants submit that the portions of Shibahara referred to by the Examiner do not disclose or teach the recited features of claims 26, 27 and 32 and the corresponding claims thereof in relation to "said lighting device has light emission control means for shifting a light emitting region in synchronism with the scanning signal applied to said scanning line" (emphasis added), as recited in independent claims 26, 27, 40 and 41 or "said lighting device has lighting control means for moving a light emitting region in synchronism with a scanning signal applied to said scanning line" (emphasis added), as recited in independent claims 32 and 42. Applicants note with this feature, even where it is difficult to divide the two regions, i.e., the dynamic region (high definition region) and the still image region (low definition region) while causing the light emitting device to emit light, the present invention enables reduction of region-to-region variations, thereby enabling an image which is excellent in balance as a whole to be displayed. Applicants submit that

Shibahara is directed to a chromaticity controller and discloses changing the color of the backlight in synchronism with scanning. However, there is no disclosure or teaching in Shibahara of moving or shifting a light emitting region in synchronism with the scanning signal applied to the scanning line. In this regard, the Examiner recognizes that Akimoto and Miyoshi also fail to disclose such features, and applicants submit that irrespective of what the Examiner contends to be obvious, the combination fails to disclose the recited features of the independent claims 26, 27, 32 and corresponding independent claims 40, 41 and 42 in the sense of 35 USC 103. See, In re Fine, supra. Thus, applicants submit that all claims patentably distinguish over the cited art and should be considered allowable.

With respect to independent claim 33 and dependent claims 34 and 35, the Examiner refers to Akimoto as disclosing driving waveforms of different levels for displaying information in one region and then displaying different information in another region referring to column 4, lines 9 - 42, 66 - 67 and column 5, lines 1 - 65. Applicants note that independent claim 33 and the corresponding independent claim 43 recite the feature of "a selection signal level to be applied to said scanning line controlling condition of said switch and a selection signal level to be applied to said opposed electrode are selection signal levels having at least two values; and wherein a level shifter is provided for varying level of an image data signal to be applied to said signal line adapting to the selection signal level of said opposed electrode. (emphasis added). Irrespective of the Examiner's contentions concerning Akimoto, applicants submit that the aforementioned recited features of claims 33 and 34 are not disclosed or taught by Akimoto in the sense of 35 USC 103 with the Examiner recognizing that the other cited art fails to disclose such features.

Additionally, it is noted that dependent claim 35 recites features similar to that of claim 26 and Shibahara fails to disclose such features, as pointed out above. New independent claim 43 and dependent claims 44 and 45 correspond to claims 33 - 35 with respect to the aforementioned features and also patentably distinguish over this cited art. Accordingly, applicants submit that these claims patentably distinguish over the cited art in the sense of 35 USC 103 and should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that claims 26, 27, 32, 33 - 35 and 40 - 45, the only claims remaining in this application, recite features not disclosed or taught in the cited art, and should be considered allowable thereover. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 503.39966X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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